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TO: Examiner Marc Jimenez
 AT: USPTO
 FAX #: 703 746-4219
 SENT BY: Ashley Pezzner
 DATE: 10/30/02
 RE: Wrong Office Action 09/764,974
 NUMBER OF PAGES: 8 (INCLUDING COVER PAGE)
 CLIENT MATTER NUMBER: 846341

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,974	01/18/2001	Hans-Jürgen Schaschke	PSB 2000/01 (8463*1)	7109

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/764,974

Applicant(s)

SCHASCHKE, HNAS-JURGEN

Examiner

Marc Jimenez

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

incorrect office action

Application/Control Number: 09/764,974
Art Unit: 3726

Page 2

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. **Claims 1-8, 13, 14, and 16-18** are rejected under 35 U.S.C. 102(b) as being anticipated by Eddy et al. (6,007,657).

Eddy et al. teach a roller comprising a roller core 2 and a roller covering 3 being composed of an elastomer or elastic plastic material (col. 4, line 20) containing fluorinated polyolefin selected from fluorocarbon plastics (col. 10, lines 23-29 and col. 14, lines 47-50).

incorrect office action

Application/Control Number: 09/764,974
Art Unit: 3726

Page 3

The fluorinated polyolefin essentially comprises polytetrafluoroethylene (PTFE) (col. 10, line 29), the elastomer or elastic plastic material comprises from 0.5 to 25% by weight of the fluorinated polyolefin selected from fluorocarbon plastics/PTFE (col. 14, lines 47-50). The fluorinated polyolefin selected from fluorocarbon plastics/PTFE is applied as powder (col. 10, lines 27-29). The elastomer or elastic plastic material is based on natural or synthetic rubber (col. 7, last paragraph to entire col. 9). The synthetic rubber could be silicone rubber (col. 9, lines 46-47).

4. **Claims 1-3, 6-9, 13, 14, 16, and 17** are rejected under 35 U.S.C. 102(e) as being anticipated by Umemoto et al. (6,020,417).

Umemoto et al. teach a roller comprising a roller core 19 and a roller covering 18 being composed of an elastomer or elastic plastic material containing fluorinated polyolefin (col. 4, line 2). The fluorinated polyolefin is selected from fluorocarbon plastics (col. 3, line 65), the fluorinated polyolefin essentially comprises polytetrafluoroethylene (col. 3, line 33 and col. 4, line 3).

5. **Claim 12** is rejected under 35 U.S.C. 102(b) as being anticipated by Nishiwaki (3,926,701).

Nishiwaki teaches running a roller 10 in a dampening system of an offset printing machine (col. 1, lines 15-18).

Note that with respect to the structure of the roll, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a

incorrect office action

Application/Control Number: 09/764,974
Art Unit: 3726

Page 4

manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Therefore the limitations that the covering being composed of an elastomer or elastic plastic material containing fluorinated polyolefin does not affect the method in a manipulative sense and has not been given patentable weight.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Takizawa et al. (5,903,808).

Eddy et al. teach the invention cited above with the exception of the elastomer or elastic plastic material being based on acrylonitrile butadiene rubber, chloroprene rubber, polyurethane rubber, polyvinyl chloride, or a suitable mixture thereof.

Takizawa et al. teach an elastomer or elastic plastic material based on chloroprene rubber (col. 4, line 14).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Eddy et al. with chloroprene rubber, in light of the teachings of Takizawa et al., in order to provide an elastomer or elastic plastic material that is durable.

incorrect office action

Application/Control Number: 09/764,974
Art Unit: 3726

Page 5

8. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Blaszak et al. (5,120,609).

Eddy et al. teach the invention cited above with the exception of the elastomer or elastic plastic material being based on a thermoplastic elastomer.

Blaszak et al. teach an elastomer or elastic plastic material being based on a thermoplastic elastomer, specifically, styrene block copolymer (col. 3, lines 53-55).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Eddy et al. with an elastomer or elastic plastic material based on a thermoplastic elastomer, in light of the teachings of Blaszak et al., in order to provide a material that has a long life with a stable coefficient of friction.

9. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Priebe et al. (5,869,188).

Eddy et al. teach the invention cited above with the exception of the elastomer or elastic plastic material being based on a castable polyurethane system comprising a two component or multicomponent polyurethane system

Priebe et al. teach a elastomer or elastic plastic material being based on a castable polyurethane system comprising a two component or multicomponent polyurethane system (col. 12, lines 21-24).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Eddy et al. with elastomer or elastic plastic material being based on a castable polyurethane system comprising a two component or multicomponent

incorrect office action

Application/Control Number: 09/764,974
Art Unit: 3726

Page 6

polyurethane system, in light of the teachings of Priebe et al., in order to provide a material that is durable and has a long life.

10. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al.

Eddy et al. teach the invention cited above with the exception of the fluorinated polyolefin being fibrous.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used fibrous material because applicant has not disclosed that using fibrous material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the powdered material taught by Eddy et al. or the claimed fibrous material because both materials in either fiber or powder form would work equally as well.

Contact Information

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies

incorrect office action

Application/Control Number: 09/764,974

Page 7

Art Unit: 3726

of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is 703-306-5965. The examiner can normally be reached on Monday-Thursday and the second Friday of the bi-week, between 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

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MJ
July 26, 2002

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